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EXAMINER

USTARIS, JOSEPH G

ART UNIT PAPER NUMBER

2617

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/664,660

Applicant(s)

LEE ET AL.

Examiner

Joseph G. Ustaris

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2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10 and 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment dated 27 December 2005 in application 10/664,660. Claims 1-8, 10, and 11 are pending. Claims 1 and 7 are amended.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond et al. (US006698020B1) in view of Krasnow et al. (US 20030226141A1).

Regarding claim 1, Zigmond et al. (Zigmond) discloses a method of displaying an advertisement using metadata (See Fig. 5; column 10 line 45 – column 11 line 49). The system constructs a user's preference for television programs and storing the user's preference on a local storage device (See Fig. 5, viewer and system information 82 and AD insertion device 80; column 11 lines 13-30), analyzes and filters advertisement parameters or "first metadata associated with an advertisement" based on the user's preference and storing the advertisement selectively corresponding to the user's preference on the local storage (See Fig. 5, ad filter 84, ad selection criteria 83, advertisement repository 86, and AD insertion device 80; column 11 lines 31-49), and

displaying a television program that comprises electronic program database, closed caption information, and triggers or "second metadata", wherein the electronic program database and closed caption information describes subject matter of the displayed television program (See Figs. 5 and 6; column 10 line 64 – column 11 line 12 and column 17 lines 21-23). The system is able to interpret the second metadata of the displayed television program and matches the second metadata of the displayed television program with the first metadata associated with the advertisement (See column 10 line 48 – column 11 line 49, column 12 line 60 – column 13 line 6, and column 13 lines 59-67). The system displays the advertisement in response to the matching (e.g. a "primetime" ad will be inserted when a trigger is received during "primetime") (See Fig. 6; column 10 line 48 – column 11 line 49 and column 13 lines 59-67). However, Zigmond does not disclose displaying the advertisement in banner form.

Krasnow et al. (Krasnow) discloses an advertisement system. Krasnow discloses displaying advertisements in a banner (page 1 section 0014, page 4 section 0047, page 7 section 0072). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Zigmond to show advertisements in a banner, as shown by Krasnow, so that the user could continue to watch a program while advertisements are being displayed.

Regarding claim 2, user's preference includes at least one of a TV star, a genre, and a broadcasting station, e.g. preferences geographical area, what channels and types of programs are preferred by the user (See Zigmond column 10 line 48 – column 11 line 30 and column 12 line 60 – column 13 line 6).

Regarding claim 3, the first metadata associated with the advertisement is provided by a third party (See Zigmond column 12 lines 15-24), herein the third party including at least one of an Internet service provider and a broadcasting station (See Zigmond column 14 line 66 – column 15 line 16).

Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond et al. (US006698020B1) in view of Krasnow et al. (US 20030226141A1) as applied to claims 1-3 above, and further in view of Calvert (US 20040078812A1).

Regarding claim 4, Zigmond shows interpreting the first data associated with advertisement based on the user's preferences and Krasnow shows using XML (See section 0068), but neither specifically state an XML parser.

Calvert shows using an XML parser (page 4 section 0038, XML parser). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Zigmond and Krasnow with the ability to use an XML parser, as shown in Calvert, so that the AD insertion device could efficiently strip the metadata for use by the processor. Furthermore, XML is a commonly used programming language and using the related processing components would allow for integration with existing systems and software.

Regarding claim 5, Calvert further shows using a DOM (page 3 section 0031-0032).

Regarding claim 6, Calvert shows using an API (page 2 section 0025).

Claims 7, 8, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond et al. (US006698020B1) in view of Calvert (US 20040078812A1).

Regarding claim 7, Zigmond discloses an apparatus for providing a selective advertisement display service using metadata (See Fig. 5; column 10 line 45 – column 11 line 49). The system comprises a digital television display (See Fig. 5, display 58; column 7 lines 50-53) and a local storage device operatively coupled to the digital television display, the local storage device storing a user preference and an advertisement selectively corresponding to the user preference (See Fig. 5, AD insertion device 80; column 11 lines 13-49). The AD insertion device 80 also serves as the matching engine operatively coupled to the digital television display (See Fig. 5, display 58; column 7 lines 50-53) displaying a television program (See column 17 lines 21-23). The television program includes electronic program database, closed caption information, and triggers or “second metadata”, wherein the electronic program database and closed caption information describes subject matter of the displayed television program (See Figs. 5 and 6; column 10 line 64 – column 11 line 12 and column 17 lines 21-23). The AD insertion device 80 selects the advertisement as a result of matching advertisement parameters or “first metadata of the advertisement” with the second metadata of the displayed television program (See column 10 line 48 – column 11 line 49, column 12 line 60 – column 13 line 6, and column 13 lines 59-67). However, Zigmond does not specifically disclose an XML parser.

Calvert shows using an XML parser (page 4 section 0038, XML parser). Therefore, it would have been obvious to one of ordinary skill in the art at the time the

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invention was made to modify Zigmond with the ability to use an XML parser, as shown in Calvert, so that the AD insertion device could efficiently strip the metadata for use by the processor. Furthermore, XML is a commonly used programming language and using the related processing components would allow for integration with existing systems and software.

Regarding claim 8, the combination of Zigmond and Calvert discloses the claimed limitations, wherein Zigmond shows that the AD insertions device is also an interpreter for interpreting the metadata associated with the television program (See Zigmond column 10 line 48 – column 11 line 49, column 12 line 60 – column 13 line 6, and column 13 lines 59-67) and Calvert teaches a XML parser (page 4 section 0038, XML parser).

Regarding claim 11, Zigmond and Calvert fail to show recording a television show in the local storage.

Official Notice is given that it is well known and expected in the art to store programming material in local storage. This allows users to conveniently play back interesting parts of video. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Zigmond and Calvert with the ability to store programming locally so that the user could conveniently access previously played/broadcasted video.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond et al. (US006698020B1) in view of Calvert (US 20040078812A1) as applied to claims 7, 8, and 11 above, and further in view of Krasnow et al. (US 20030226141A1).

Regarding claim 10, Zigmond in view of Calvert does not disclose displaying the advertisement in banner form.

Krasnow et al. (Krasnow) discloses an advertisement system. Krasnow discloses displaying advertisements in a banner (page 1 section 0014, page 4 section 0047, page 7 section 0072). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Zigmond in view of Calvert to show advertisements in a banner, as shown by Krasnow, so that the user could continue to watch a program while advertisements are being displayed.

Response to Arguments

3. Applicant's arguments with respect to claims 1-8, 10, and 11 have been considered but are moot in view of the new ground(s) of rejection.

Applicant is reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph G. Ustaris whose telephone number is 571-272-7383. The examiner can normally be reached on M-F 7:30-5PM; Alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher S. Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JGU

March 7, 2006



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